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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,925	04/26/2000	John Albert Kembel	10351-0007	1658

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INNOVATION MANAGEMENT SCIENCES  
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EXAMINER
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AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 02/12/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

file

# Office Action Summary

Application No.

09/558,925

Applicant(s)

KEMBEL ET AL.

Examiner

Joseph E. Avellino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 1/16/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-30 are pending in this examination.

#### ***Specification***

2. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the application papers do not conform to 37 CFR 1.52(1)(ii) which states that the top margin must be at least two (2) inches. A substitute copy of the specification in conformance with the aforementioned rule is required.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5-7, 11-21, and 23-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al. (USPN 5,977,964) (hereinafter Williams).

3. Referring to claim 1, Williams discloses a method for presenting distributable computer readable media to a user in response to a user request, said method comprising the steps of:

identifying a definition of a Networked Information Monitor (NIM) (col. 6, lines 25-49);

defining a NIM frame for said NIM using said definition (col. 6, lines 25-49);

retrieving content (advertisements) for said NIM (col. 6, lines 25-49); and

placing said content in a NIM viewer defined by said frame (col. 6, lines 25-49).

4. Referring to claim 2, Williams discloses obtaining an identification for a definition of said NIM (col. 10, lines 25-42); and

retrieving said definition of said NIM using said identification (col. 10, lines 38-42).

5. Referring to claim 3, Williams discloses retrieving said definition of said NIM from a user profile resident on a server computer (col. 6, lines 20-25).

6. Referring to claim 5, Williams discloses identifying a definition including a frame specification (col. 6, lines 50-67).

7. Referring to claim 6, Williams discloses identifying a definition including a frame specification with a NIM size (col. 6, lines 50-67).

8. Referring to claim 7, Williams discloses identifying a definition including a frame specification with a menu definition (television menu grid) (col. 7, lines 30-40).

9. Referring to claims 11 and 12, Williams discloses multiple windows displayed on the screen at the same time (col. 6, lines 4-17) displaying different content and different display formats. It is inherent that these different windows be able to be uniquely identifiable by the "preferred display layouts" (col. 6, lines 63-67) to allow the user a customized viewing experience and to allow separate styles to be applied to separate windows.

10. Referring to claim 13, Williams discloses the step of identifying a definition including a NIM category assigned by said user (col. 6, lines 25-30).

11. Referring to claim 14, Williams discloses the step of identifying a definition including an action field for a user-specified event condition (display of television schedule grid) (col. 7, lines 30-58).

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12. Referring to claim 15, Williams discloses the step of sending a message (request) when said user-specified event condition is satisfied (col. 7, lines 30-58; col. 8, lines 14-24).

13. Claims 16-21, and 23-30 are rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Bayeh et al. (USPN 6,012,098) (hereinafter Bayeh).

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15. Williams discloses a method for presenting distributable computer readable media as stated in the claims above. Williams does not disclose that the definition is in XML format. Bayeh discloses a document definition written in XML format (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Bayeh with Williams to provide an isolation technique which uses widely accepted programming techniques and data formatting notations as stated in Bayeh (col. 3, lines 54-58).

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Ferrel et al. (USPN 6,230,173) (hereinafter Ferrel).

16. Referring to claim 8, Williams discloses a method for presenting distributable computer readable media as stated in the claims above. Williams does not disclose the step of identifying a definition including a frame specification with a title bar definition. Ferrel discloses of identifying a definition including a frame specification with a title bar definition (col. 7, lines 24-28). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ferrel with Williams to provide a separation of design from content and increased flexibility for presenting content to subscribers or users as stated in Ferrel (col. 3, lines 30-36).

17. Referring to claim 9 and 10, Williams discloses a method for presenting distributable computer readable media as stated in the claims above. Williams does not

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disclose identifying a definition including a control field used to render computer readable media located by an address. Ferrel discloses a definition including a control field used to render computer readable media located by an address (col. 7, lines 5-45). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ferrel with Williams to provide a separation of design from content and increased flexibility for presenting content to subscribers or users as stated in Ferrel (col. 3, lines 30-36).

### ***Response to Arguments***

18. The Applicant has requested that the objection to the specification to be held in abeyance. The objection will be withheld until the case is in preparation for allowance.

19. Applicant's arguments filed January 16, 2004 have been fully considered but they are not persuasive.

20. Applicants argued in substance that, (1) the Williams patent does not read upon a Network Information manager such as defined by the specification.

21. Applicant states that the specification clearly defines the term "networked information monitor" as "a fully configurable frame with one or more controls; the frame through which content is optionally presented (specification, p. 7, lines 1-4). However the term "fully configurable frame" can be broadly construed to mean "a window to



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display content in which parameters of the window, such as size and location, are configurable". Williams discloses that additional user preferences may be stored in the user profile database 800 include preferred display layouts (e.g. window sizes and locations) (col. 6, lines 50-63). Williams further discloses that the window may display content (an example would be stock quotes from the user profile's selected portfolio) col. 6, lines 5-15). Furthermore, the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (703) 305-7855. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JEA  
February 6, 2004



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100